

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

By the foregoing amendment, claims 2-4, 16-19, 22-39 and 42 have been canceled without prejudice or disclaimer. Applicants reserve the right to file a continuation application directed to any of the canceled subject matter. Additionally, claims 1, 5-7, 9, 10, 20, 21, 40 and 41 have been amended. Support for such amendments can be found throughout the originally filed application. Thus, no new matter has been added.

Turning now to the Official Action, Claims 25-39 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing new matter. This rejection is respectfully traversed. However, to expedite prosecution in the present application and not to acquiesce to the Examiner's rejection, claims 25-39 have been canceled without prejudice or disclaimer. Since the Examiner's rejection has now been rendered moot, withdrawal of such rejection is respectfully requested.

Claims 1-7, 9, 10, 16-19, 21, 22, 25-39, 41 and 42 have been objected to for minor informalities. Initially it is noted that claim 1 should not have been objected to because, being an independent claim, claim 1 does not "refer[] to a previous claim." However, claims 5-7, 9, 10, 21 and 41 have been amended in accordance with the Examiner's suggestions to obviate these objections. Claims 2-4, 16-19, 22, 25-39 and 42 have been canceled without prejudice or disclaimer to the subject matter recited therein. Accordingly, withdrawal of the claim objections is respectfully requested.

Claims 35-39 have been rejected under 35 U.S.C. § 112, second paragraph, as purportedly failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. This rejection is respectfully traversed. As described above, to expedite prosecution in the present application and not to acquiesce to the Examiner's rejection, claims 35-39 have been canceled without prejudice or disclaimer. Accordingly, withdrawal of this now moot rejection is respectfully traversed.

Claims 1-3, 5-7, 9-11, 16, 17, 19-21, and 23-41 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly not being enabling. This rejection is respectfully traversed.

As discussed previously, to expedite prosecution in the present application and not to acquiesce to the Examiner's rejection, claims 2, 3, 16, 17, 19 and 23-39 have been canceled without prejudice or disclaimer.

As to claims 1, 5-7, 9-11, 20, 21, 40 and 41 applicants provide the following arguments.

Currently pending independent claim 1 recites an "isolated DNA coding for a protein having an amino acid sequence that has a sequence identity of 50% or more with an amino acid sequence as shown in any one of SEQ ID NOs: 2, 4, 6, 8 or 12 and activity that transfers a glycoside to the 5 position of a flavonoid." The Examiner has admitted that the specification provides adequate enablement for such subject matter. Claims 5-7 and 9-11 are dependent upon claim 1 and thus also satisfy the enablement requirement.

Currently pending independent claims 20 and 40 (and dependent claims 21 and 41, respectively) now specifically recite the nucleotide sequences "as set forth in

SEQ ID NOs: 1, 3, 5, 7 or 11, or having at least 50% sequence identity thereto". The specification of the present application provides adequate support to enable one of ordinary skill in the art to make and/or use the invention commensurate in scope with these currently claims without resorting to undue experimentation.

In view of the above, the Examiner is respectfully requested to withdraw the enablement rejection.

Claims 1-3, 5-7, 9-11, 16, 17, 19-21, 23, 24, and 39-41 have been rejected under 35 U.S.C. § 112, first paragraph, as purportedly lacking written description. This rejection is respectfully traversed.

As discussed previously, to expedite prosecution in the present application and not to acquiesce to the Examiner's rejection, claims 2, 3, 16, 17, 19 and 23, 24 and 39 have been canceled without prejudice or disclaimer. Further, as described above, independent claims 1, 20 and 40 have been amended. Applicants believe that the specification provides adequate written description to support the currently pending claims.

Hence, in view of the above, the Examiner is respectfully requested to withdraw the written description requirement.

Finally, claims 1, 2, 5-7, 9-11, 16-21, 23-26, 29-31, 34-36, and 39-41 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Brugliera et al. (U.S. Patent No. 5,859,334) in light of Jonsson et al. (*Planta* 160:341-347 (1984)). This rejection is respectfully traversed.

The rejection as it applies to claims 2, 16-19, 23-26, 29-31, 34-36 and 39 is rendered moot in light of the cancellation of such claims. These claims have been canceled without prejudice or disclaimer, simply to expedite prosecution and not to

acquiesce to the Examiner's rejection. As to the remaining claims, applicants believe that the combination of references as cited by the Examiner fails to teach or suggest the currently pending claims.

Therefore, withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.

In the event that there are any questions relating to this Amendment and Reply, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 6, 2004

By: 
Susan M. Dadio
Registration No. 40,373

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620